

REMARKS

This paper responds to the Office Action mailed on January 13, 2006.

Claims 1, 3, 11, 18-20, 22, 24, 29, 31, 39, 45-47, 49 and 51 are amended, no claims are canceled, and no claims are added; as a result, claims 1-60 remain pending in this application.

§112 Rejection of the Claims

Claims 1-60 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Claims 1, 11, 18 and 24 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between steps. Claims 2-10, 12-17, 19-23 and 25-28 are included in this rejection because of their dependency.

With respect to the 112 rejection for being incomplete with reference to claims 1, 11, 18 and 24, Applicant respectfully disagrees. The fabrication data and the measured data are representative of some of the conditions in the electronic device fabrication facility. Storing such data and then analyzing the data is one possible method of detecting conditions in the facility. Other methods of detecting conditions are discussed in the present application.

Applicant calls attention to page 6, lines 25-27, where data is measured and captured. That data is then used to analyze the conditions. For at least these reasons, Applicant respectfully requests withdrawal of the rejection under § 112 for omitting essential steps.

Claims 1, 11, 18, 24, 29, 39, 45 and 51 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

With respect to the claim elements ‘measuring fabrication data’ and ‘storing fabrication data’, Applicant presently amends the latter to recite ‘storing measured data.’ Support for the amendment can be found at least at page 13, line 23 of the present application. Applicant submits that no new matter has been added due to the amendment.

With respect to the claim element ‘the data set,’ Applicant thanks the examiner for pointing out the clerical error and presently amends the first instance to recite ‘a data set.’

With respect to claim 3, Applicant presently amends ‘the subparts’ to recite ‘subdivisions.’ Additionally, ‘a workpiece’ is amended to recite ‘workpieces.’

Applicant requests withdrawal of the rejection under 35 U.S.C. § 112, second paragraph

§102 and §103 Rejection of the Claims

Claims 1-60, as understood, were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative under 103(a) 35 U.S.C. as being unpatentable over Herberich et al. (U.S. 4,719,694).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.¹ It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*”²

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness.³ To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references.⁴

Applicant presently amends claims 1, 11, 18, 24, 29, 39, 45 and 51 to remove the language that the Office Action asserted was vague. Applicant respectfully submits that Herberich does not state each and every element of claims 1-60 and as such does not make out a *prima facie* case of anticipation. Applicant fails to find in Herberich each and every element of claims 1-60. The Office Action fails to cite to any particular statement in Herberich, and merely asserts that Herberich discloses the elements and includes a figure from the document. For at least these reasons, Applicant respectfully requests the withdrawal of the rejection under 35 USC 102(b) and allowance of claims 1-60.

With respect to the assertion that claims 1-60 are non-obvious in light of Herberich, Applicant respectfully submits that for at least the reasons stated above, Herberich fails to state

¹ *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).
² *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

³ *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

⁴ *Id.*

each and every element of claims 1-60 and in the absence of any other cited document, or an affidavit, Applicant respectfully requests withdrawal of the 35 USC 103(a) rejection and allowance of claims 1-60.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

NAOKI TOYOSHIMA ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9587

Date

13 April '06

By


Timothy B. Clise
Reg. No. 40,957

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of April, 2006.

Name

KATE GANNOV

Signature

Kate G